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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,202	01/14/2004	Tung-Ching Tseng	2002-0350/24061.484	3558
42717	7590	03/30/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			DEO, DUY VU NGUYEN	
			ART UNIT	PAPER NUMBER
			1765	
DATE MAILED: 03/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/757,202	Applicant(s) TSENG ET AL.	
	Examiner DuyVu n. Deo	Art Unit 1765	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 1-3, 6, 8-10 and 13.
Claim(s) objected to: _____.
Claim(s) rejected: 15-19.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Primary Examiner
Duy-Vu N. Deo
3/27/06

[Signature]

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's argument that the final rejection is premature because it offers a new ground of rejection by providing new and different rationale and citing three different embodiments is found unpersuasive because the reference is the same and used in the previous rejection. There is no new reference cited in the final rejection; therefore, there is no new ground of rejection. Also citing other embodiments to provide clearer evidence and support for the rejection from the same reference does not introduce a new ground of rejection.

Referring to applicant's argument that the rejection does not satisfy requirement (B), (C), and (D) because it combines multiple embodiment and it fails to identify one of these multiple embodiments that is to be modified and why and what modifications would be needed in the one selected embodiment is found unpersuasive because neither requirement (B) and (C) require to select just one of these embodiments. There is nothing to prevent combining of various embodiments in a reference.

In contrast the rejection satisfy the requirements (B), (C) and (D) as:

Requirement (B): the different is "unlike claimed invention, Lee doesn't describe the initial polishing comprises a control of polishing time so as to avoid over-polishing of a stop layer."

Requirement (C) and (D): the proposed modification and the motivation for the modification "however, he suggests leaving some of the polished oxide layer on the polishing stop layer (paragraph g0088)). Therefore, one skilled in the art at the time of the invention would find it obvious to control the polishing time in order to leave some of the polished oxide layer on the polishing stop layer."

Referring to claim 15, as provided in the final rejection, wherein a first planarization slurry contains 0.2 wt% of APC, the second slurry would have 0.4-0.8 wt% of APC in order to have a high selectivity ratio as suggested by Lee, this second slurry with a more concentrated of APC would read on claimed final planarization with a more concentrated composition of the slurry. There would probably no such thing as same slurry but yet with different concentrations of composition. Two slurry having different concentration of composition would provide two different slurry. All it needs is a more concentration of composition, of which can be concentration of any component of the slurry. In this case it would be the APC concentration. Furthermore, the claim doesn't have the limitation of "different concentrations of the same slurry." As long as it contain the similar components, it would satisfy claimed "said chemical mechanical polishing slurry" and Lee's second slurry would satisfy claimed "said chemical mechanical polishing slurry" because it contains the similar components with a higher APC concentration.

Referring to applicant's argument that additional motivation must be shown in order to establish a prima facie case of obviousness is found unpersuasive because it is not required to provide two motivations. The motivation for the obviousness has been provided. That would be "he (Lee) suggests leaving some of the polished oxide layer on the polishing stop layer (paragraph g0088)). Therefore, one skilled in the art at the time of the invention would find it obvious to control the polishing time in order to leave some of the polished oxide layer on the polishing stop layer." Furthermore, applicant has not traversed this motivation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971)..